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Examiner: Emmanuel S. Luk
Group Art Unit: 2833

Remarks/Arguments

Claims 1-64 are pending in the application. No claims have been amended in this response.

Initially, Applicants would like to address the impropriety of the finality of the rejection. The standards for when a final rejection is proper on a second Office Action are set out in MPEP 706.07(a), which in relevant part provides:

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p). ...”

In the final Office Action mailed July 12, 2004, the Examiner raised a new ground of rejection (the indefiniteness rejection based on *In Ex parte Lyell*) that was neither necessitated by Applicants’ amendment of the claims (Applicants have yet to amend the claims in this case) nor based on information submitted in any information disclosure statement (the indefiniteness rejection is not based on a prior art reference). Thus, according to MPEP 706.07(a), the finality of the rejection is improper and premature. Withdraw of the finality of the rejection is respectfully requested.

Moving on to the rejections of the claims, claims 1, 10-13, 17, 23, 24, 43, 51, 52, 53, and 61-64 stand rejected as being indefinite under 35 U.S.C. 112, second paragraph. The rejection is respectfully traversed.

Specifically, the basis for the indefiniteness rejection is stated as being “A single claim that claims both apparatus and method step of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph”, citing *In Ex parte Lyell*, 17 USPQ2d 1548. In applying *Lyell*, the Examiner asserts that the use of the ratio of the gap to the line speed to set the range of the gap is forbidden by *Lyell* because the “line speed is a process limitation in the apparatus claim.”

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Applicants respectfully submit that the Examiner's reliance on *Lyell* and its holding is misplaced and incorrectly based on a rote application of a generalization of the holding of *Lyell*. When one looks at the facts and holding of *Lyell* one can easily see that *Lyell* is not applicable to the current claims and that the use of the line speed is not a method step.

A more detailed look at *Lyell* will prove enlightening. First, the claim at issue in *Lyell* is an unambiguous mixing of apparatus claim format with method claim format. The *Lyell* claim is set out below:

2. An automatic transmission tool in the form of a workstand and method for using same comprising:

a support means,

and [sic] internally splined sleeve affixed upright to said support means,

a threaded adjustment bolt threadably engaged through a hole in the bottom of said support means and projecting upward through said support frame into said sleeve,

and further comprising the steps of

1. positioning the output end of an automatic transmission onto said upright sleeve,
2. removing the internal components of said automatic transmission from the casing of said transmission,
3. repairing and replacing said internal components back into said casing, and
4. adjusting said internal components for fit and interference by means of adjusting said upwardly projecting adjustment bolt.

As is clearly visible, the *Lyell* claim begins as a traditional apparatus claim and abruptly changes with the phrase "and further comprising the steps of" to a method claim, with the steps of the method for using the apparatus following.

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Applicants' claim format is nothing like the *Lyell* claim format. None of the claims in the current application contain express method steps as found in the *Lyell* claim in combination with apparatus elements. Claim 1 of the current application is illustrative of the claim format used in this case:

1. An apparatus for extruding a polymeric foam from an extrudate comprising a polymeric resin and a blowing agent for providing the extrudate with a cellular structure upon extrusion, the apparatus comprising:

an extruder having an inlet adapted to receive the extrudate;
an extrusion die having an annular die opening forming an outlet for the extruder through which the extrudate is adapted to be pulled at a predetermined line speed, the extrusion die defining a longitudinal axis, and the annular die opening being concentrically oriented relative thereto and positioned therefrom at a first radial distance;

a choke ring having an opening defined by an annular choke ring surface, the choke ring being positioned relative to the extruder such that the annular die opening is received within the choke ring opening, the choke ring opening being concentric about the longitudinal axis and positioned therefrom a second radial distance; and

wherein the difference between the second radial distance and the first radial distance comprises a gap, *the size of the gap being determined by the ratio of the gap (in units of millimeters) to the line speed (in units of millimeters per second) and the ratio ranges from 0.001 to 0.020 second.* (emphasis added)

As is clearly seen, all of the elements of claim 1 are structural elements: an extruder, an extrusion die, a choke ring, and a gap. This claim format is hardly the unambiguous combination of apparatus claims and method steps that was found improper in *Lyell*.

The claims of the current application, in addition to not having the prohibited format in *Lyell*, are substantively different than the *Lyell* claim. The claim language at issue (italicized in claim 1) is not a prohibited method step, but is a structural limitation. The italicized language very clearly defines the size of the gap, which is inherently a structural limitation. That the size

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of the gap is defined by a range that is dependent on the line speed, an operational parameter, does not serve to convert the gap size limitation to method step, especially the clear and unambiguous method step that was prohibited in *Lyell*.

Lyell itself acknowledge that "hybrid" claims containing both apparatus and process elements are permitted, *Lyell* at 12. What *Lyell* found indefinite was when the combination of apparatus and method steps made it impossible to place the claim in one of the statutory categories: process, machine, manufacture or composition of matter. *Lyell* at 11-12. This concern of being able to properly categorize the claim is not raised by Applicants claims. The claims at issue are clearly apparatus/machine claims. The use of the process variable (line speed) to define a physical characteristic (the gap) of the machine, does not cloud the issue of whether the claim is a process or method claim. It is clearly an apparatus claim.

In summary, the claims rejected for indefiniteness do not comprise the prohibited combination of apparatus and method steps. In fact, the asserted method step is nothing more than an operational parameter used to define a physical characteristic and is not a method step. The claims at issue are clearly apparatus claims and do not fall within the holding of *Lyell*. Therefore, claims 1, 10-13, 17, 23, 24, 43, 51, 52, 53, and 61-64 are definite and allowable over the prior art of record.

The double patenting rejection has already been addressed in that Applicants' have already filed an appropriate terminal disclaimer.

Given that the claims are definite and that the double patenting rejection has been addressed with the terminal disclaimer, it is respectfully submitted that the claims are in condition for allowance.

If there are any questions, please contact the undersigned attorney.

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Respectfully submitted,

WAYNE J. Myer & Blaine M. Kelly

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By: 

Mark A. Davis, Reg. No. 37,118
MCGARRY BAIR PC
171 Monroe Avenue, NW, Suite 600
Grand Rapids, Michigan 49503
616-742-3500

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